

Appl. No. : 10/680,523
Filed : October 7, 2003

REMARKS

In the Office Action mailed April 30, 2009, Claims 1-42 were rejected by the Examiner. In response, Applicant has amended Claims 1, 6, 12, 22, 26, 30, 39, and 42. Applicant respectfully requests reconsideration of the application in view of the amendments above and remarks below.

Discussion of the Rejection under 35 U.S.C. § 101

Claims 1-5, 22-25, 30-38, and 39-41 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Examiner stated that the claims "are not tied to any particular apparatus for which to determine the cost-effective use of medications, thus recite purely mental steps. As noted by the Examiner, and stated in *In Re Bilski*, "[a] claimed process is surely patentable under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing."

Applicant has amended Claims 1, 22, 30, and 39 so as to recite "one or more processors" thereby tying each of the claims to a particular machine. In view of this amendment, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 101.

Discussion of the Rejection under 35 U.S.C. § 112, ¶ 2

Claims 1-48 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention. In particular, the Examiner rejected Claims 1-5, 22-25, 30-38, and 39-41 as being incomplete for omitting essential elements. As noted above, Applicant has amended Claims 1, 22, 30, and 39 so as to recite "one or more processors." The Examiner also rejected noted that Claims 1, 6, 12, 22, 26, 30, 39, and 42 contained elements lacking antecedent basis. Applicant has amended these claims so as to provide antecedent basis for these elements. In view of these amendments, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 112.

Appl. No. : 10/680,523
Filed : October 7, 2003

Discussion of the Rejection under 35 U.S.C. § 103(a)

Claims 1-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Greenburg (U.S. Patent Pub. No. 2004/0039602) in view of Bodsworth (U.S. Patent Pub. No. 2002/0095314). Applicant respectfully submits that, as stated in the M.P.E.P. at § 2143, "The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art." *See also KSR v. Teleflex*, 550 U.S. 398, 82 USPQ2d 1395. Applicant further submits that the cited references fail to describe at least one feature of each of Claims 1-48.

Claim 1 recites "adjusting, using one or more processors, a patient cost for at least one medication treatment therapy according to a cost-effectiveness of the medication treatment therapy." Each of independent Claims 6, 12, 22, 26, 30, 39, and 42 recite a substantially similar feature. Greenburg and Bodsworth, alone or in combination, fail to disclose such a feature. Although the Examiner asserted that this feature was disclosed in Greenburg, at paragraph [0032] and in Bodsworth in paragraphs [0023], [0024], and [0052], Applicant respectfully disagrees for the reasons set forth below.

As stated at paragraph [0008] of the instant specification, "for each medication covered by a patient's insurance carrier, or listed on the insurer's formulary, a physician can be immediately informed as to the patient cost for that medication, wherein the patient cost is commonly referred to as the copayment, or copay." Paragraph [0024] of the instant specification further explains that the "patient copayment adjustment module 66 adjusts the copayment for each medication treatment therapy according to the cost-effectiveness of each treatment as determined by the medication therapy cost analysis module 60."

Greenburg, at paragraph [0032], discloses that "protocols can be established on the basis of clinical pathways, research protocols or cost of care. Accordingly, the protocol database 32 can, for example, assist the treatment module 28 and/or the clinician to prompt clinicians to offer the most cost effective approach where medically necessary, to specify treatment with selected medications, or brands of medications." Thus, Greenburg discloses a "cost of care" and that a

Appl. No. : 10/680,523
Filed : October 7, 2003

treatment approach may be based on this "cost of care." However, Greenburg does not disclose a patient cost, nor does Greenburg disclose adjusting the patient cost.

Greenburg discloses, at paragraph [0040], that a "selected billing level option is displaying in dialog box 168" and that "the documentation module 36 may use this information to generate bills for the patient." However, Greenburg does not disclose adjusting these bills "according to a cost-effectiveness of the medication therapy." Further, Greenburg teaches away from such adjustment noting that "the billing module ensures that the clinician has properly document[ed] the patient encounter, etc. to ensure that third party regulations are met to allow payment/reimbursement at the *maximum* extent."

Bodsworth, at paragraph [0023], discloses that a "database of prescriptions and possible alternatives also comprises data on costs of the prescriptions and alternatives, and the system is provided with means to select, or to rank, said alternatives on the basis of costs." Bodsworth, at paragraph [0024], discloses that "the system may also be provided with means to calculate any savings made when the practitioner does choose an alternative prescription." At paragraph [0052], Bodsworth discloses that such a system can be embodied as a computer program. Thus, Bodsworth discloses "costs of the prescriptions and alternatives" and that the system can select or rank alternatives based on these costs. However, Bodsworth does not disclose a patient cost, nor does Bodsworth disclose adjusting the patient cost.

As Greenburg and Bodsworth, alone or in combination, fail to disclose "adjusting, using one or more processors, a patient cost for at least one medication treatment therapy according to a cost-effectiveness of the medication treatment therapy" as recited in Claim 1 or the substantially similar language recited in the other independent Claims, Applicant submits that a *prima facie* case of obviousness has not been established with respect to independent Claims 1, 6, 12, 22, 26, 30, 39, and 42.

Claims 2-5, 7-11, 13-21, 23-25, 27-29, 31-38, 40-41, and 43-8 depend directly or indirectly on one of the above-discussed independent Claims. Applicant respectfully submits that, as stated in the M.P.E.P. at § 2143.03, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." In view of the nonobviousness of the independent Claims, Applicant submits that the dependent Claims are also nonobvious.

Appl. No. : 10/680,523
Filed : October 7, 2003

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

6/20/2003

By: _____



Eric M. Nelson
Registration No. 43,829
Attorney of Record
Customer No. 20,995
(619) 235-8550

7118814
051109